

REMARKS

Upon entry of the above amendment, claims 1-6, 10-14, 18 and 22-38 will be pending in this application. Currently amended claims 1 and 2, and newly added claims 33-38 now recite the specific proton pump inhibitors disclosed in the present specification. Applicant respectfully submits that the amendment does not introduce new matter within the meaning of 35 U.S.C. §132. Accordingly, entry of the amendment is respectfully requested.

1. Rejection of claims 1-6, 10-14 and 23-32 under 35 U.S.C.

§112, first paragraph

The Official Action states that claims 1-6, 10-14 and 23-32 are rejected under 35 U.S.C. §112, first paragraph for lack of enablement. In particular, the Official Action states in relevant part that "...the specification, while being enabled for the process of oxidizing pantoprazole in enantiomeric form, does not reasonably provide enablement for the process of any unknown process of any unknown proton pump inhibitor (PPI) having a sulphinyl structure. The specification fails to prepare any unknown PPI having a sulphinyl structure."

Applicants have amended independent claims 1 and 2 to recite the specific PPI compounds disclosed in the present specification, and as such the basis for this rejection has been removed.

Further, Applicants respectfully draw the Examiner's attention to the data on pages 11-12 of the present specification that shows

examples for the preparation of optically pure (R)-pantoprazole, and (S)-omeprazole Na salt. This data provides sufficient enablement for a person having ordinary skill in the art to prepare an optically pure PPI using the process recited in the presently pending claims.

Accordingly, the bases for the rejection of claims 1-6, 10-14 and 23-32 under 35 U.S.C. §112, first paragraph have been removed, and the Examiner is respectfully requested to withdraw this rejection to the claims.

2. Rejection of claims 1-3 under 35 U.S.C. §112, 2nd paragraph

The Official Action states that claims 1-3 are rejected under 35 U.S.C. §112, 2nd paragraph as being indefinite. In particular, the Official Action states in relevant part that "[t]he expression proton pump inhibitor (PPI) is indefinite in claims 1-3 because it is not clearly defined."

Applicants respectfully direct the Examiner's attention to paragraphs 2 and 4, at page 1 of the present specification which indicates that "[p]yridin-2-ylmethylsulphinyl-1H-benzimidazoles and compounds of a closely related structure,... owing to their H⁺/K⁺-ATPase-inhibitory action,... are also referred to as proton pump inhibitors or abbreviated PPI...".

As such, claims 1-3 are clear and definite and Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

3. Provisional double patenting rejection of claims 1-6, 10-14,

18 and 23-32

The Official Action states that claims 1-6, 10-14, 18 and 23-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8, 10-15 and 21-28 of copending U.S. Patent Application No. 10/536,891 and claims 1-22 of copending U.S. Patent Application No. 11/597,373. The Examiner asserts that although the conflicting claims are not identical, they are not patentably distinct from each other because the instant process of preparing a mixture of a PPI having a sulphanyl structure is recited therein.

Applicants respectfully note that copending U.S. Application No. 10/536,891 recently issued as U.S. Patent No. 7,301,030. Accordingly, submitted herewith is a Terminal Disclaimer under 37 CFR 1.321(c) over U.S. Patent No. 7,301,030 obviating this rejection.

Regarding the provisional rejection of claims 1-6, 10-14, 18 and 23-32 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of copending U.S. Patent Application No. 11/597,373, Applicants respectfully request that this rejection be held in abeyance until all other rejections are overcome. Applicants, at that time, will either address the rejection or file a terminal disclaimer.

CONCLUSION

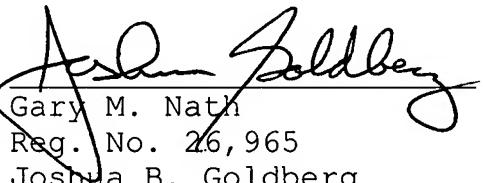
In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw all rejections and allow pending claims 1-6, 10-14, 18 and 22-38. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned attorney if she has any questions or comments.

Respectfully submitted,
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